

Applicant Muntermann  
Attorney Docket (H)02MUN0018USP  
US Application 10/049,934

### Remarks

#### Specification

Paragraph [0004] of the specification is amended to delete reference to the claims and to insert the claims referred to. This amendment to the specification does not introduce new matter.

#### Claim Rejections - 35 USC § 101

Claims 26 to 29 were rejected as claiming overlapping classes of invention.

We have clarified the wording of claim 26 to contain only device features. Claims 27 and 28 have been amended correspondingly.

However, we do not understand this rejection regarding claim 29, because this is a product-by-process-claim, which inherently relates to a process or method, i.e. to method claim 10.

#### Claim Rejections - 35 USC § 112(2)

Claims 1 to 29 were rejected as being indefinite.

We have clarified claim 1 by introducing the wording "wherein the at least one ablation or mapping electrode has an electrolytically treated surface".

This introduced feature describes how the electrode surface is treated to obtain the reduced number of electrical interference centers, defining the scope of the claim more specifically, such that someone skilled in the art is enabled to work out the claimed subject matter.

We have amended method claim 10 to now recite active method steps, as proposed by the Examiner.

#### Claim Rejections - 35 USC § 102 (b)

Claims 1-9 are rejected as being anticipated by Cunningham et al.

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Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

Cunningham et al. does not disclose each feature of the rejected claims.

Cunningham et al. merely describes an ablation catheter with an electrode 20 of a certain form. In this regard, an electrode diameter of about two millimeters is given (see col. 6, lines 49 to 61).

However, neither this passage nor anywhere else in the description of Cunningham et al. addresses the microscopic surface quality of the electrode.

In contradiction to that, merely the macroscopic form is described as by the diameter measures as given in the above-cited passage.

In particular, Cunningham et al. does not disclose any electrode with a treated surface to reduce the number of electrical interference centers disturbing the recording of ECG-signals, as provided in the current claims of the present invention.

Therefore, the subject matter of amended claim 1 distinguishes from the disclosure of Cunningham et al. at least by the feature:

wherein the at least one ablation or mapping electrode  
has an electrolytically treated surface.

Consequently, it is respectfully submitted that the amended claim 1 is not anticipated by Cunningham et al.

Claim Rejections – 35 USC 103(a)

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Claims 10-12, 15-26, 28 and 29 stand rejected as being unpatentable over Cunningham et al in view of Eggers et al.

MPEP 2142 sets forth "The Legal Concept of *Prima Facie* Obviousness."

To establish a *prima facie* case of obviousness under 35 USC 103(a) the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or imply suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (MPEP 706.02(j))

The cited references do not motivate or suggest to a skilled artisan to combine these references to produce applicant's invention as claimed.

Cunningham et al is discussed above.

Eggers et al. describes systems and methods for electrosurgical removal of calcified deposits. However, those calcified deposits are removed from valve leaflets while minimizing damage to cardiac tissue (see col. 3, lines 6 to 14).

According to present claim 1, a catheter for the ablation of biological tissue is defined. This catheter is for "destroying" myocardial tissue. Therefore, the present catheter and the catheter of Eggers et al. are provided for nearly contradictory applications.

Moreover, the difference between the subject matter of current claim 10 and the prior art is clarified in that a vessel is provided with the solution for immersing the ablation or mapping electrode in the solution to treat that electrode.

Also, apparatus claim 26 is amended accordingly.

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Neither Cunningham et al. nor Eggers et al. – alone or in combination - disclose or give a hint to such treating vessel with a solution for an ablation or mapping electrode. In contradiction to that, no hint regarding a surface treatment of the electrode could be found at all.

Therefore, it is respectfully submitted that subject matter of claims 10 and 26 is not obvious in view of a combination of Cunningham et al. and Eggers et al.

Therefore, it respectfully submitted that subject matter of the independent claims is allowable and, therewith, also the subject matter of the dependent claims.

Double Patenting

A terminal disclaimer with respect to copending application 10/049,932 is submitted herewith.

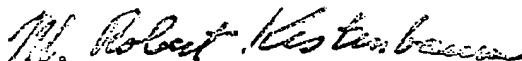
Miscellaneous

The passage “in particular according to claim 1” in claim 5, the passage “preferably at 10 Hz” in claim 20 and the passage “preferably from 30 to 100 mA<sub>eff</sub>” in claim 25 are deleted.

Wherefore, please give further consideration to the claims as amended and allow this case.

A one-month extension of time in which to respond to the outstanding Office Action is hereby requested. Credit Card Payment Form PTO-2038 is enclosed to cover the prescribed Small Entity one-month extension fee of \$55.00.

Respectfully submitted,



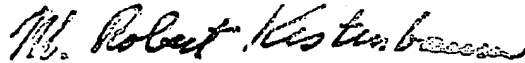
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I hereby certify this correspondence is being faxed to Commissioner for Patents, Alexandria, Virginia by facsimile transmission on August 23, 2004, fax number (703) 872-9306.



M. Robert Kestenbaum

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